REMARKS

In this Amendment, Applicant has cancelled Claims 33, 35 – 38 and 40, without prejudice or disclaimer, has rewritten Claims 34 and 39 in independent format. It is respectfully submitted that no new matter has been introduced by the amended claims. All claims are now present for examination and favourable reconsideration is respectfully requested in view of the preceding amendments and the following comments.

REJECTION UNDER 35 U.S.C. § 102(b)

Claims 33, 35 – 38 and 40 have been rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by the UK Patent Application GB 2 097 024 A, hereinafter UK '024. Claims 1 – 2 and 4 – 21 have been rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by the International Application WO 96/15292 A1, hereinafter WO '292.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, Claims 33, 35 – 38 and 40 have been cancelled. Therefore, the rejection to 33, 35 – 38 and 40 is moot.

Regrading the rejection to Claims 1 – 2 and 4 – 21, Applicant respectfully submits that the Examiner has misunderstood the disclosure of WO '292. The Examiner asserts that Examples 37-39 on page 18 of WO '292 disclose solutions including a total amount of chloride falling within the claimed range of 30 to 1500 mg/l. However, WO '292 clearly states that in **each** of Examples 1 to 39, the conversion coating solution **additionally** contains **13.2 g/l of $CeCl_3.7H_2O$**, 1% of a 30 wt% H_2O_2 solution and a pH of 2.0 which is adjusted, if necessary, **with HCl** (*See WO '292 specification, page 11, lines 11 – 13*). Accordingly, the concentrations of Mn (chloride) salt and Cu (chloride) salt disclosed in Examples 37 to 39 do not represent the only sources of chloride ions in those solutions. Applicant respectfully attaches herewith the calculations of chloride concentrations in Examples 37 to 39, which were provided by one of the inventors, Simon Hardin (*See*

Attachment: Calculation of Total Chloride in Prior Art Document WO 96/15292 A1 Examples 37-39). Each of Examples 37 to 39 contains an additional 3768 mg/l of chloride derived from $CeCl_3.7H_2O$ and 354.5 mg/l chloride derived from pH adjustment using HCl. This corresponds to a total chloride concentration more than twice that of the upper limit of the chloride concentration presently defined in Claim 1.

In addition, even if the Mn chloride and the Cu chloride concentrations given in Examples 37 to 39 were representative of the total chloride concentration in the coating solutions, (e.g. the sources of H^+ and Ce did not include chloride) they still would not fall within the claimed total chloride concentration range of 30 to 1500 mg/l. The chemical formulae of the two chlorides are $MnCl_2.4H_2O$ and $CuCl_2.2H_2O$ as disclosed in WO '292 (*See WO '292 specification, page 15, lines 4 – 5*). Accordingly, from the attached calculations, 50 ppm of $MnCl_2.4H_2O$ and 10 ppm $CuCl_2.2H_2O$ would yield 17.9 mg/l and 4.2 mg/l chloride, respectively, giving a total chloride concentration of 22.1 mg/l. This is clearly lower than the lower limit of the claimed chloride concentration of 30 mg/l.

The Examiner additionally indicates that because WO '292 teaches that the rare earth elements may be derived from compounds other than chlorides (*See WO '292 specification, page 6, line 2*) and that transition metal chlorides may be present in solution in a broad range of concentrations which overlap the claimed range of total chloride concentration. However, as Applicant points out as above, all of the Examples 1 – 39 **additionally** contains **13.2 g/l of $CeCl_3.7H_2O$**, 1% of a 30 wt% H_2O_2 solution and a pH of 2.0 which is adjusted, if necessary, **with HCl**. None of the solution compositions exemplified in WO '292 falls within the scope of Claim 1. Therefore, a merely general statement in WO '292 would not constitute enabling and specific disclosure of the total chloride contents as required in the amended claims.

Accordingly, the rejection under 35 U.S.C. § 102(b) has been overcome and withdrawal of the rejection under 35 U.S.C. § 102 (b) is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 33 – 40 and 44 – 45 have been rejected under 35 U.S.C. § 103, as allegedly being unpatentable over WO '292 in view of UK '024.

It is respectfully submitted that in view of presently claimed invention, the rejection has been overcome. In particular, Claim 33, 35 – 38 and 40 have been cancelled. Therefore, rejections against these claims are moot. In addition, Claims 34 and 39 have been re-written to independent format. The re-written Claims 34 and 39 and Claims 44 – 45 contain the limitation of total chloride concentration within the range of from 30 to 1500 mg/litre. As stated above, such range is neither disclosed nor suggested in WO '292 or UK '024.

It is respectfully submitted that one of ordinary skilled in the art would not discern the present concentrate in Claims 34, 39, 44 – 45 merely by applying the use of concentrates, as taught in UK '024, to the solution compositions taught in WO '292. In addition, there is nothing in WO '292 which would suggest the desirability of preparing concentrates. Even if WO '292 and UK '024 are combined, there is nothing to suggest which particular components of the coating solution should be present in the concentrate, nor the absolute concentrations and/or relative proportions of those components.

In addition, the invention as presently claimed in Claims 34, 39, 44 – 45 has significant advantages over the prior art WO'292 and UK '024 because the selection of a specific range of total chloride concentration which is high enough to allow successful deposition of a conversion coating, but low enough to prevent corrosion of stainless steel containers and equipment (*See specification of the present application, page 6, line 31 to page 7, line 1; page 14, lines 20 – 30; page 15, lines 4 – 11*). The identification of that range is neither disclosed nor suggested in WO '292 or UK '024. Therefore, it is

respectfully submitted that Claims 34, 39, 44 – 45 are not obvious in light of WO '292 and UK '024.

Accordingly, the rejection under 35 U.S.C. § 103 has been overcome and withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

DOUBLE PATENTING

Claims 1 – 2, 4 – 21, 33 – 40 and 44 – 45 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting, allegedly as being unpatentable over Claims 1 – 2, 4 – 21 and 34 – 40 of the co-pending Application No. 09/988,578.

Applicant respectfully submits the attached "Terminal Disclaimer To Obviate A Provisional Double Patent Rejection Over A Pending Second Application" in compliance with 37 CFR 1.321(c) to overcome the rejections. It is respectfully submitted that this application and the pending U.S. Application Number 09/988,578, filed on November 20, 2001 are commonly owned by the Applicant.

Therefore, rejections under the judicially created doctrine of double patenting have been overcome. Accordingly, withdrawal of the rejections under the judicially created doctrine of double patenting is respectfully requested.

REQUEST FOR INTERVIEW

Applicant respectfully requests either a telephonic or an in-person interview should the applicant as presently amended not be in condition for allowance.

Having overcome all outstanding grounds of rejection, the application is now in condition for allowance, and prompt action toward that end is respectfully solicited.

Respectfully submitted,

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Enclosures:
Calculation of Total Chloride
Terminal Disclaimer